

REMARKS

Entry of the foregoing, reexamination and reconsideration of the subject application are respectfully requested in light of the amendments above and the comments which follow.

As correctly noted in the Office Action Summary, claims 28-44 were pending, with claims 45-47, 49, 50 and 55 being withdrawn from consideration. By the present response, claims 28 has been amended. Thus, upon entry of the present response, claims 28-44 are pending and await further consideration on the merits.

Support for the foregoing amendments can be found, for example, in at least the following locations in the original disclosure: the original claims.

RESTRICTION/ELECTION

Applicants note that the restriction requirement of September 10, 2007 has been made final. Applicants continue to traverse the assertions upon which the restriction requirement is based. In particular, claims 45-47, 49-50 and 55 each depend ultimately from claim 28. Thus, these claims share all of the features recited in independent claim 28. Thus, there is clearly a common technical feature shared amongst all of these claims. It is further asserted in paragraph 1 of the Official Action that there is no "special technical features" in common between the withdrawn claims and the elected claims "because the technical feature is not novel over the prior art" This assertion is respectfully traversed. For at least the reasons explained below, there is at least one special technical feature which is recited in claim 28 which is novel with respect to the applied prior art. This being the case, as set forth in MPEP §1850: "if the independent claims avoid the prior art and satisfy

the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims." For at least the reasons set forth herein, rejoinder of claims 45-47, 49, 50 and 55 is respectfully requested.

CLAIM REJECTIONS UNDER 35 U.S.C. §102

Claims 28-44 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,876,494 to Bomal et al. (hereafter "*Bomal et al.*") on the grounds set forth in paragraph 7 of the Official Action. For at least the reasons noted below, this rejection should be withdrawn.

The present invention is directed to a process for preparing a low water-uptake precipitated silica. A process performed according to the principles of the present invention is set forth in claim 28. Claim 28 recites:

28. *A process for preparing a low water-uptake precipitated silica, comprising the following successive steps:*

- (a) producing an initial feedstock comprising a silicate, the silicate concentration in the feedstock, expressed in SiO₂ equivalent, being less than 15 g/l;*
- (b) adding an acidifying agent, bringing the pH of the medium to a value of between 7 and 8 ;*
- (c) in the resulting medium, simultaneously adding a silicate and an acidifying agent, the respective amounts of added silicate and acidifying agent over time being specifically selected such that, throughout the addition:*
 - the pH of the reaction medium remains between 7 and 8;*
 - the silicon concentration in the medium, expressed in SiO₂ equivalent, remains less than or equal to 35 g/l;*
- (d) adding an acidifying agent to the medium resulting from step (c), so as to bring the medium at a pH of between 3 and 6.5; and*
- (e) filtering the resulting aqueous silica dispersion, then drying the filter cake obtained at the end of the filtering step.*

Bomal et al. clearly fails to anticipate the process set forth in claim 28.

Bomal et al. describes a process for the preparation of precipitated silicas having very good dispersibility and reinforced properties. However, the process described therein does not anticipate the process set forth in claim 28 above. In particular, as evident from the above, claim 28 requires, *inter alia*:

. . . (b) adding an acidifying agent, bringing the pH of the medium to a value of between 7 and 8;

(c) in the resulting medium, simultaneously adding a silicate and an acidifying agent, the respective amounts of added silicate and acidifying agent over time being specifically selected such that, throughout the addition: . . . the silicon concentration in the medium, expressed as SiO₂ equivalent, remains less than or equal to 35 g/l

By contrast, the process described by *Bomal et al.* includes a step (ii) which comprises adding an acidifying agent to the base stock until at least 5% of the quantity of M₂O present in the base stock is neutralized. However, this process does not correspond to the recited step (b) which requires bringing the pH of the medium to a value of between 7 and 8.

In addition, with respect to step (c) recited in claim 28, *Bomal et al.* is completely silent with respect to the requirement of simultaneously adding silicate and an acidifying agent in a manner which maintains the silicon concentration in the medium, expressed as SiO₂ equivalent, to less than or equal to 35 g/l throughout the addition.

Thus, for at least the reasons explained above, *Bomal et al.* fails to anticipate the process recited in claim 28. Reconsideration and withdrawal of the rejection is respectfully requested.

The remaining claims depend either directly or indirectly upon claim 28. Thus, these claims are also novel over the teachings of *Bomal et al.* for at least the same reasons noted above.

OBVIOUSNESS-TYPE DOUBLE PATENTING

Claims 28, 34-36 and 42 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 25 of U.S. Patent Application No. 10/583,417 on the grounds set forth in paragraph 9 of the Official Action.

This rejection is respectfully traversed. It is asserted in paragraph 9 of the Official Action that certain claims of the present application are provisionally rejected on the basis of obviousness-type double patenting over claim 25 of the above-identified copending patent application on the basis that these claims "are drawn to a similar process of producing precipitated silica involving the mixture of a silicate and an acidifying agent." The grounds for rejection clearly fail to establish a *prima facie* case of obviousness-type double patenting.

As explained in MPEP §804, the analysis employed in an obviousness-type double patenting determination parallels the guidelines of a rejection pursuant to 35 U.S.C. §103(a). Thus, the factual inquiries set forth in Graham v. John Deere must be employed when making an obviousness-type double patenting analysis. These factual inquiries are:

- (A) determine the scope and content of a patent claim relative to claim in the application at issue;
- (B) determine the differences between the scope and content of the patent claim as determined in (A) and the claim in the application at issue;
- (C) determine the level of ordinary skill in the pertinent art; and

(D) evaluate any objective indicia of non-obviousness.

Moreover, any obviousness-type double patenting rejection should make clear (A) the differences between the inventions defined by the conflicting claims; and (B) the reason why a person of ordinary skill in the art would conclude that the invention defined in the claims at issue would have been an obvious variation of the invention defined in a claim in the patent/application. When taken in light of the above-stated requirements, it is clear that the grounds for rejection fail to establish a *prima facie* case of obviousness-type double patenting. Reconsideration and withdrawal of the rejection is respectfully requested.

Applicants note that should the rejection based on prior art (*Bomal et al.*) be overcome by the present response, applicants would be amenable to filing an appropriate Terminal Disclaimer to obviate the above-noted grounds for rejection in order to advance the present application to allowance.

Claims 28, 30, 34-36 and 42 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 33, 35-39, 57 and 61-62 of U.S. Patent Application No. 11/921,073 on the grounds set forth in paragraph 10 of the Official Action.

This rejection is respectfully traversed. It is asserted on page 10 that the above-identified claims contained in the present application are properly rejected on an obviousness-type double patenting rationale for the reason that "they disclose a similar process of producing precipitated silica where the scope of the invention is overlapping each other and obvious to each other." This assertion is respectfully traversed. Nowhere do the grounds for rejection even identify what the difference is between the identified claims of the current application and the above-identified

compending application are, and there is also no explanation as to why any such differences would have been obvious to one of ordinary skill in the art, as clearly required to establish a *prima facie* case of obviousness-type double patenting. Thus, for the reasons explained above, reconsideration and withdrawal of the rejection is respectfully requested.

Again, applicants note that should the rejection of the claims of the present application on the basis of the applied prior art be overcome by the present response, applicants would be amenable to the preparation and filing of an appropriate Terminal Disclaimer to render the above-identified rejection moot if doing so would advance the present application to allowance.

CONCLUSION

From the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

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